



UNITED STATES PATENT AND TRADEMARK OFFICE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/716,209	10/09/96	PRADIER	L ST94014-US
		EXAMINER	
		18M1/0729	
		GLICKER, S	
		ART UNIT	PAPER NUMBER
		1818	9
DATE MAILED: 07/29/97			

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 9/17/96

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 27-54 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 Claim(s) \_\_\_\_\_ is/are allowed.  
 Claim(s) \_\_\_\_\_ is/are rejected.  
 Claim(s) \_\_\_\_\_ is/are objected to.  
 Claim(s) 27 - 54 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
 The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
 The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.  
 The specification is objected to by the Examiner.  
 The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been  
 received.  
 received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of Reference Cited, PTO-892  
 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  
 Interview Summary, PTO-413  
 Notice of Draftsperson's Patent Drawing Review, PTO-948  
 Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Serial Number: 08/716,209

Art Unit: 1818

**Part III DETAILED ACTION**

1. This application was filed as a 35 USC 371 application: This application contains the following inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1. In order for all inventions to be examined, the appropriate additional examination fees must be paid.

Group I, claim(s) 27-41 and 48-50 are drawn to adenovirus encoding BDNF and host cells.

Group II, claim(s) 42-43, drawn to methods of using adenovirus encoding BDNF.

Group III, claim(s) 44-47, drawn to pharmaceutical compositions of adenovirus encoding BDNF.

Group IV, claim(s) 51-54, drawn to implants.

The Examiner considers that the Application does not comply with the requirements of unity of invention (Rules 13.1, 13.2, and 13.3) for the reasons indicated below:

The inventions listed as Groups I-IV do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking Groups I-IV appears to be that they all relate to an adenovirus encoding BDNF. However, Barde et al. (1993) teach an adenovirus encoding BDNF (column 18, line

Art Unit: 1818

32 to column 20, line 25). Therefore, the technical feature linking the inventions of Groups I-IV does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

The special technical feature of Group I is considered to be adenovirus encoding BDNF and host cells.

The special technical feature of Group II is considered to be methods of using adenovirus encoding BDNF.

The special technical feature of Group III is considered to be pharmaceutical compositions of adenovirus encoding BDNF suitable for use *in vivo*.

The special technical feature of Group IV is considered to be host cells transfected with an adenovirus encoding BDNF suitable for use as cellular therapy implants *in vivo*.

Accordingly, the Groups I-IV are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Serial Number: 08/716,209

-4-

Art Unit: 1818

3. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (703) 308-6571. The examiner can normally be reached on Mondays through Thursdays from 0730 to 1800.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, Ph.D., can be reached on (703) 308-4310. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

SG

Stephen Gucker

July 21, 1997

  
PAULA K. HUTZELL  
SUPERVISORY PATENT EXAMINER  
GROUP 1800